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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

BOLDEN, ELIZABETH A

ART UNIT PAPER NUMBER

1755

DATE MAILED: 09/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,586

Applicant(s)

LA GRECA ET AL.

Examiner

Elizabeth A. Bolden

Art Unit

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-21 and 23-25 is/are rejected.
- 7) ☒ Claim(s) 16-18, 22 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn.

Claim Objections

Claims 16 and 20 are objected to because of the following informalities: Minor typographical errors.

In both claims 16 and 20, line 6 recites "Na₂" and should read Na₂O.

Claim 19 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Independent claim 16 recites a range for SO₃ of 0.1 to 0.5 weight percent, while dependent claim 19 does not contain any SO₃.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20, 21, 23, and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by De Meringo et al., U.S. Patent 5,952,254.

De Meringo et al. disclose an inorganic fiber where the composition is sufficiently specific to anticipate the compositional limitations of Claims 20, 21, 23 and 25. See column 4, 47-48, column 5, lines 20-30, column 6, lines 12-20 and 48-58, column 8, lines 61-65, and MPEP 2131.03.

Since the composition of the reference is the same as those claimed herein it follows that the glasses of De Meringo et al. would inherently possess the same bio-solubility properties recited in claim 20. See MPEP 2112.

Claims 19-21, 23, and 25 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Furtak, French Patent 2,781,788.

Furtak discloses a biodegradable fiber where the composition is sufficiently specific to anticipate the compositional limitations of Claims 19-21, 23, and 25. See Derwent Abstract of Furtak and MPEP 2131.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19-21 and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bauer et al., U.S. Patent 5,401,693.

Bauer et al. teach a biosoluble glass fiber composition in mole percent. See column 6, lines 26-33.

It is believed that Bauer et al. teach a composition whose ranges overlap the compositional limitations of claims 19-21 and 23-25. See column 6, lines 26-33. Overlapping ranges have been held to establish *prima facie* obviousness. MPEP 2144.05.

Bauer et al. fail to teach any examples or compositional ranges that are sufficiently specific to anticipate the compositional limitations of claims 19-21 and 23-25. However, as noted above, overlapping ranges have been held to establish *prima facie* obviousness. MPEP 2144.05.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have selected from the overlapping portion of the ranges disclosed by the Bauer et al. because overlapping ranges have been held to establish *prima facie* obviousness.

Allowable Subject Matter

Claims 16-18, 22, and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:
The biologically-degradable or bio-soluble glass fiber having the composition as recited in the

instant claims, which comprises SO_3 as a required element to improve the biological degradability.

Response to Arguments

Applicant's arguments see page 6, filed 16 June 2003, with respect to Claims 16-18, 22, and 26 have been fully considered and are persuasive. The rejections of claims 16-18, 22, and 26 have been withdrawn.

Applicant's arguments filed 16 June 2003 in view of claims 19-21 and 23-25 have been fully considered but they are not persuasive. Applicants' argue that the rejections over De Meringo et al., Furtak, and Bauer et al. do not disclose the use of SO_3 as a component, however claims 19-21 and 23-25 do not require SO_3 in the composition. Independent claim 20 recites that the SO_3 content is from 0 to 1 weight percent. Independent claim 25 recites that the SO_3 content is less than 0.35 weight percent, which includes no SO_3 .

Applicants' further argues that the rejections over De Meringo et al., Furtak, and Bauer et al. disclose, teach or make obvious the limitations that glass fiber composition comprises Al_2O_3 from 1.1 to 1.25 weight percent, Na_2O from 17.5 to 18.5 weight percent, K_2O from 0.6 to 1 weight percent, and $\text{B}_2\text{O}_3+\text{P}_2\text{O}_5$ greater than 5. This argument is not deemed persuasive since the references disclose or suggest the ranges of components, which either anticipate or make obvious the compositional components of instant claims 19-21 and 23-25. See the above rejections.

Furthermore, the Applicants argue that De Meringo et al. teach no specific examples that anticipate the composition of the instant claims. This is not deemed persuasive since the reference is not limited to the example alone. See MPEP 2123. De Meringo et al. disclose an inorganic fiber where the composition is sufficiently specific to anticipate the compositional limitations of Claims 20, 21, and 23. See column 4, 47-48, column 5, lines 20-30, column 6, lines 12-20 and 48-58, column 8, lines 61-65, and MPEP 2131.03 and the above rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth A. Bolden whose telephone number is 703-305-0124. The examiner can normally be reached on 8:30am to 6:00 pm with alternating Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark L. Bell can be reached on 703-308-3823. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

EAB
2 September 2003


KARL GROUP
PRIMARY EXAMINER
GROUP 1755